Remarks/Arguments:

The pending claims are 54-73. Claims 54-73 have been allowed.

INTRODUCTION

Prosecution of this application was closed on February 22, 2006 pursuant to *Ex parte Quayle* and further proceedings were put into suspense pursuant to Applicants' petition filed on August 21, 2006. On May 8, 2007, Applicants filed a second petition for a further suspension of prosecution. The second petition was denied.

As indicated in the August 21, 2006 and May 8, 2007 petitions, the present application and U.S. Patent No. 6,416,542 (Marcade) are commonly owned.

ELIMINATING THE NEED FOR AN INTERFERENCE

MPEP § 2304.5 governs the situation where an application and a patent are commonly owned. It provides, in part:

> The examiner may require an election of priority between the application and other application or patent. 35 U.S.C. 132(a)
>
> In making the election, the owner must eliminate the commonly claimed subject matter. This may be accomplished by. . .amending the application claims such that they no longer interfere.

Independent claims 54 and 58 have been amended herein such that they no longer interfere. No new matter is introduced therein. As a result of the amendments to independent claims 54 and 58, the need for an Interference between the present application and Marcade has been eliminated. In addition, Applicants hereby formally withdraw their request for an Interference.

For the Examiner's convenience, Applicants are providing tables below that show the amendments to Applicants' claims 54 and 58, with tracking, alongside claims 1 and 16, respectively, of Marcade. The tables therefore not only show the amendments to claims 54 and 58, but also demonstrate the differences between the subject matter of claims 54 and 58 and that of claims 1 and 16 of the '542 Marcade patent.

Goicoechea amended claim 54	Marcade claim 1
A modular prosthesis for repairing an ~~aortic~~ aneurysm in a vessel ~~an aorta extending from a heart~~ of a patient, comprising:	A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:
a prosthesis portion	a base member
~~expandable radially between a collapsed configuration and an expanded configuration and~~	foldable radially between a collapsed configuration and an expanded configuration and
extending longitudinally between a proximal end and a distal end,	extending longitudinally between a proximal end and a distal end,
said prosthesis portion having an ~~single~~ inlet at said proximal end;	said base member having a single inlet at said proximal end;
a proximal prosthesis portion	a primary tubular limb
~~expandable radially between a collapsed configuration and an expanded configuration and~~	foldable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said proximal prosthesis portion having ~~a single inlet at said proximal end and a single~~ an outlet at said distal end,	said primary limb having a single inlet at said proximal end and a single outlet at said distal end,
said proximal prosthesis portion being formed separately from said prosthesis portion and	said primary limb being formed separately from said base member and
~~being adapted to lie in the aorta with said proximal end pointing toward the heart and~~	being adapted to lie in the aorta with said proximal end pointing toward the heart and
~~sized to fit a diameter of the aorta;~~	sized to fit a diameter of the aorta;
each of said prosthesis portion and said proximal prosthesis portion including	each of said base member and said primary limb including
a flexible layer and	a flexible layer and
~~an expandable~~ a stent radially supporting said flexible layer ~~along substantially the entire length thereof~~; and	an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.

Goicoechea amended claim 58	Marcade claim 16
A modular prosthesis for repairing an ~~aortic~~ aneurysm in a vessel ~~an aorta extending from a heart~~ of a patient, comprising:	A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:
a prosthesis portion	a base member
~~expandable radially between a collapsed configuration and an expanded configuration and~~	foldable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end;	having a proximal end and a distal end;
a proximal prosthesis portion	a primary tubular limb
~~expandable radially between a collapsed configuration and an expanded configuration and~~	foldable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said proximal prosthesis portion being formed separately from said prosthesis portion and	said primary limb being formed separately from said base member and
~~being adapted to lie in the aorta with said proximal end pointing toward the heart and~~	being adapted to lie in the aorta with said proximal end pointing toward the heart and
~~sized to fit a diameter of the aorta~~;	sized to fit a diameter of the aorta;
each of said prosthesis portion and said proximal prosthesis portion including	each of said base member and said primary limb including
a flexible layer and	a flexible layer and
~~an expandable~~ a stent radially supporting said flexible layer ~~along substantially the entire length thereof~~;	an expandable stent radially supporting said flexible layer along substantially the entire length thereof;
~~at least one~~ a distal prosthesis portion	at least one secondary tubular limb
~~expandable radially between a collapsed configuration and an expanded configuration and~~	foldable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said distal prosthesis portion including	said secondary tubular limb including

a flexible layer and	a flexible layer and
~~an expandable~~ a stent radially supporting said flexible layer ~~along substantially the entire length thereof~~; and	an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	connecting means for connecting said proximal end of said secondary limb to said distal end of said base member.

THERE IS NO NEED FOR A SUPPLEMENTAL SHOWING PURSUANT TO 37 C.F.R. § 41.202(a)(6)

The March 21, 2008 Office Action has required Applicants to supplement their request for interference with the addition of a showing pursuant to 37 C.F.R. § 41.202(a)(6) by providing charts showing where Applicants' disclosure provides a constructive reduction to practice within the scope of the interfering subject matter for Application Nos. 08/463,987 and 08/317,763 (The Office Action inadvertently misidentified the '987 application as 08/462,987). The Office Action has required this showing because, in its view, the '987 and '763 applications are in the chain of priority and are therefore needed in order to accord Applicants the benefit of Application No. 08/312,881. Applicants respectfully disagree because this requirement is now moot for two reasons.

First, as indicated above, Applicants have eliminated the need for an interference by amending independent claims 54 and 58 so that the subject matter claimed in this application no longer interferes with Marcade and by formally stating that they are no longer requesting an interference.

Second, Applicants claimed priority to Application No. 08/312,881 via two different paths. The first path includes the '987 and'763 applications. The second path, however, recited priority directly to co-pending Application No. 08/312,881, without the intervening applications. Specifically, Applicants' Preliminary Amendment filed on July 9, 2003 stated, in part: "The present application is also a continuation-in-part of Serial No. 08/312,881." Based on that path, Appendix G, referenced in Section H of Applicants' August 21, 2006 Response, was sufficient to comply with the requirement of 37 C.F.R. § 41.202(a)(6) in order to be accorded benefit of the '881 application.

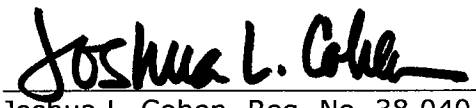
Even though Applicants do not believe that it is necessary to provide claim charts for the '987 and '763 applications, and to ensure that this Amendment is fully responsive to the

Office Action dated March 21, 2008, they are nevertheless providing the charts in an abundance of caution as Appendices J and K which provide an element-by-element recitation of the claims of the Goicoechea application (prior to their amendment herein) and an indication of the passages in Application Nos. 08/317,763 and 08/463,987, respectively, where, at the very least, the disclosure provides constructive reduction to practice. Applicants incorporate previously submitted Appendices A through I by reference.

CONCLUSION

For all of the above reasons, Applicants request that that the PTO withdraw its requirement for additional claim charts pursuant to 37 C.F.R. § 41.202(a)(6), that it withdraw its prior indication that the question of priority of invention would be properly decided by an interference between the present application and Marcade, and that it allow amended claims 54 and 58, along with dependent claims 55-57 and 59-73, thereby placing the present application in condition for allowance.

Respectfully submitted,



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Encls.: Appendices J and K

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The Director is hereby authorized to charge or credit Deposit Account No. **18-0350** for any additional fees, or any underpayment or credit for overpayment in connection herewith.

APPENDIX J

APPLICATION OF THE GOICOECHEA CLAIMS TO THE DISCLOSURE OF U.S. APPLICATION NO. 08/317,763

Application claim	**Disclosure of Application No. 08/317,763**
Claim 54	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 29, lines 5-21; Figs. 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 29, line 22 to page 30 line 7
extending longitudinally between a proximal end and a distal end,	page 29, lines 5-13; Figs. 1B, 6
said prosthesis portion having a single inlet at said proximal end;	Figs. 1B, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 27, lines 19-27; page 28, lines 13-21
having a proximal end and a distal end,	Figs. 1A, 6, 14-20
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	Figs. 1A, 6, 7
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 22, lines 17-22; page 23, line 11 to page 26, line 8
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 28, line 13 to page 29, line 4; Figs. 14-20
sized to fit a diameter of the aorta;	page 28, line 13 to page 29, line 4; Figs. 14-20

each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 29, lines 10-13; page 32, lines 16-17; page 27, lines 3-8; Figs. 5-7
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	page 29, lines 8-18; Fig. 1B; page 32, lines 16-17; page 27, lines 19-25; Fig. 1A
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	Figs. 1A, 6; page 4, line 26 to page 5, line 13
Claim 55	
wherein said joining means includes a friction fit engagement between said distal end of said proximal prosthesis portion in said expanded configuration and said proximal end of said prosthesis portion in said expanded configuration.	page 4, line 26 to page 5, line 13
Claim 56	
wherein said proximal prosthesis portion has a first diameter at said proximal end and a second diameter less than said first diameter at said distal end.	page 30, line 23 to page 31, line 4
Claim 57	
further comprising securing means projecting from said proximal end of said proximal prosthesis portion for securing said proximal prosthesis portion to the aorta.	page 27, lines 14-18
Claim 58	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7

a prosthesis portion	page 25, lines 22 to page 26, line 8; Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration and	page 27, lines 19-27
having a proximal end and a distal end;	Figs. 1A, 6, 14-20
a proximal prosthesis portion	Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration and	page 27, lines 19-27; page 28, lines 13-21
having a proximal end and a distal end,	Figs. 1A, 6, 14-20
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 22, lines 17-22; page 23, line 11 to page 26, line 8
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 28, line 13 to page 29, line 4; Figs. 14-20
sized to fit a diameter of the aorta;	page 28, line 13 to page 29, line 4
each of said prosthesis portion and said proximal prosthesis portion including	
A flexible layer	page 27, lines 3-8; Figs. 5-7
and an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	page 27, lines 19-25; Figs. 5-7
at least one distal prosthesis portion	page 29, line 19 to page 30, line 7; Figs. 1A, 1B, 6
expandable radially between a collapsed configuration and an expandable configuration and	page 27, lines 19-27; page 29, line 22 to page 30, line 7
having a proximal end and a distal end,	Figs. 1A, 1B, 6, 14-20
said distal prosthesis portion including	

a flexible layer and	page 27, lines 3-13; page 29, lines 10-14; Fig. 6
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	Figs. 1A, 1B, 6, 14-20
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	page 4, line 26 to page 5, line 13; page 26, line 25 to page 27, line 2; Figs. 1A, 1B, 6; page 29, line 22 to page 30, line 7
Claim 59	
wherein said connecting means includes a friction fit engagement between said proximal end of said distal prosthesis portion in said expanded configuration and said distal end of said prosthesis portion in said expanded configuration.	page 29, line 22 to page 30, line 7
Claim 60	
wherein said distal prosthesis portion has a length between said proximal end and said distal end of between about 4 cm and about 15 cm.	page 26, lines 19-25; page 29, lines 16-17

APPENDIX K

APPLICATION OF THE GOICOECHEA CLAIMS TO THE DISCLOSURE OF U.S. APPLICATION NO. 08/463,987

Application claim	**Disclosure of Application No. 08/463,987**
Claim 54	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 29, lines 5-21; Figs. 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 29, line 22 to page 30 line 7
extending longitudinally between a proximal end and a distal end,	page 29, lines 5-13; Figs. 1B, 6
said prosthesis portion having a single inlet at said proximal end;	Figs. 1B, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 27, lines 19-27; page 28, lines 13-21
having a proximal end and a distal end,	Figs. 1A, 6, 14-20
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	Figs. 1A, 6, 7
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 22, lines 17-22; page 23, line 11 to page 26, line 8
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 28, line 13 to page 29, line 4; Figs. 14-20
sized to fit a diameter of the aorta;	page 28, line 13 to page 29, line 4; Figs. 14-20

each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 29, lines 10-13; page 32, lines 16-17; page 27, lines 3-8; Figs. 5-7
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	page 29, lines 8-18; Fig. 1B; page 32, lines 16-17; page 27, lines 19-25; Fig. 1A
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	Figs. 1A, 6; page 4, line 26 to page 5, line 13
Claim 55	
wherein said joining means includes a friction fit engagement between said distal end of said proximal prosthesis portion in said expanded configuration and said proximal end of said prosthesis portion in said expanded configuration.	page 4, line 26 to page 5, line 13
Claim 56	
wherein said proximal prosthesis portion has a first diameter at said proximal end and a second diameter less than said first diameter at said distal end.	page 30, line 23 to page 31, line 4
Claim 57	
further comprising securing means projecting from said proximal end of said proximal prosthesis portion for securing said proximal prosthesis portion to the aorta.	page 27, lines 14-18
Claim 58	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7

a prosthesis portion	page 25, lines 22 to page 26, line 8; Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration and	page 27, lines 19-27
having a proximal end and a distal end;	Figs. 1A, 6, 14-20
a proximal prosthesis portion	Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration and	page 27, lines 19-27; page 28, lines 13-21
having a proximal end and a distal end,	Figs. 1A, 6, 14-20
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 22, lines 17-22; page 23, line 11 to page 26, line 8
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 28, line 13 to page 29, line 4; Figs. 14-20
sized to fit a diameter of the aorta;	page 28, line 13 to page 29, line 4
each of said prosthesis portion and said proximal prosthesis portion including	
A flexible layer	page 27, lines 3-8; Figs. 5-7
and an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	page 27, lines 19-25; Figs. 5-7
at least one distal prosthesis portion	page 29, line 19 to page 30, line 7; Figs. 1A, 1B, 6
expandable radially between a collapsed configuration and an expandable configuration and	page 27, lines 19-27; page 29, line 22 to page 30, line 7
having a proximal end and a distal end,	Figs. 1A, 1B, 6, 14-20
said distal prosthesis portion including	

a flexible layer and	page 27, lines 3-13; page 29, lines 10-14; Fig. 6
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	Figs. 1A, 1B, 6, 14-20
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	page 4, line 26 to page 5, line 13; page 26, line 25 to page 27, line 2; Figs. 1A, 1B, 6; page 29, line 22 to page 30, line 7
Claim 59	
wherein said connecting means includes a friction fit engagement between said proximal end of said distal prosthesis portion in said expanded configuration and said distal end of said prosthesis portion in said expanded configuration.	page 29, line 22 to page 30, line 7
Claim 60	
wherein said distal prosthesis portion has a length between said proximal end and said distal end of between about 4 cm and about 15 cm.	page 26, lines 19-25; page 29, lines 16-17